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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,267	10/13/2000	Jeffrey Glenn	240042052403	1206

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EXAMINER
BRUMBACK, BRENDA G

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 03/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/687,267	GLENN, JEFFREY	
	Examiner	Art Unit	
	Brenda G. Brumback	1642	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *13-21*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Brenda Brumback
BRENDA BRUMBACK
PATENT EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: applicant's arguments and the Glenn II Declaration are not commensurate in scope with the claims. Applicant's claims are broadly drawn to methods of treating viral infections via inhibiting prenylation of a protein contained in the virus infecting the subject comprising administering to the subject an agent selected from a peptide that mimics the action of a CXXX, XCXX, XXCX, or XXXC box, an inhibitor of enzymes in the pathway of prenyl lipid synthesis, an inhibitor of a prenyl transferase, and a mimic of a prenyl group. The Glenn II Declaration and attached exhibits provide evidence of efficacy in the absence of toxicity for a single embodiment of the claimed agents, inhibitors of a prenyl transferase, in inhibiting prenylatation of a protein in a single embodiment of the broadly claimed virus, the hepatitus delta virus. It is suggested that applicant either narrow the claims to coincide with the evidence presented or submit additional arguments or evidence commensurate in scope with the broad scope currently claimed.

Applicant's arguments regarding the "burden of proof" issue (Ex parte Bhide) in the enablement analysis are noted; however, the general teachings of unpredictability which are found in the art and which were exemplified in the cited references provide such a reason for one skilled in the art to question enablement of in vivo therapy. Regarding applicant's arguments pertaining to human clinical trials, applicant is reminded that no such requirement has been made. In response to applicant's agument that the Gibbs reference is not supported by any testing data, absent some evidence to the contrary, the Gibbs reference appears to be a review of the state of the art. Numerous articles are referenced in Gibbs which do appear to be supported by testing data. Furthermore, applicant has not addressed the additional references which were cited in the enablement rejection.

Applicant's arguments regarding the metes and bounds of the recited mimic of a prenyl group are noted; however, the disclosure fails to teach what is encompassed within a mimic of a prenyl group and fails to provide guidance as to how the mimics can be made or administered. Applicant argues that a mimic of a prenyl group should behave as a prenyl group, but it remains unclear what defining function is to be used to determine what is encompassed within the group.